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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,802	12/22/2005	Yasushi Washio	SHIGA7.35APC	1118
20995 7590 08/02/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER LE, HOA VAN	
			ART UNIT 1752	PAPER NUMBER
			NOTIFICATION DATE 08/02/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

## Office Action Summary

Application No.

10/561,802

Applicant(s)

WASHIO ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on (Notice of Panel Decision on 070307).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_

This is in response to Notification of Panel Decision made and mailed on 03 July 2007 that there is a reopen prosecution.

I. Claims 1-2 are related to a composition while dependent claims 3 and 4 are related to a method of using the composition. They are not considered to be patentably different or distinct and stand or fall together. However, applicants should disagree, urge or show otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as disagreed or urged on the record in the next Office action.

II. A restriction will be made when there is an amendment to remove the applied Sato et al (5,985,525) on the record. It is now notified for the record.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (5,985,525) considered in view of Anzures et al (6,900,003).

Sato et al disclose, teach and suggest a developer and its use. The composition comprising an organic quaternary ammonium base as claimed. Please see the whole disclosure of each of the applied references, especially in Sato et al at col.2:41-64 and 5:61 to 6:11.

Sato et al do not cited an alkali metal salt of a diphenyl oxide sulfonic containing group. However, it is known in the art to use an alkali metal salt of a diphenyl oxide containing group for the advantage of reducing residue in a developing solution and/or on a developing substrate (col.5:53-59). Evidence, can be seen in at least Anzures et al at col. 5:66 to 6:29.

Since the above applied references are generally related to developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use, include or cited an alkali metal salt of a diphenyl oxide sulfonic containing group for reasonable expectation of obtaining the advantage of reducing residue in a developing solution and/or on a developing substrate as disclosed, taught and suggested in Anzures et al.

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Applicant's arguments filed 24 May 2007 have been fully considered but they are not persuasive.

The arguments have little value since the above rejection using a new set of the references.

IV. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anzures et al (6,900,003) considered in view of Sato et al (5,985,525).

Anzures et al disclose, teach and suggest a developer and its use. The composition comprising an alkali metal salt of a diphenyl oxide containing group as claimed. Please see the whole disclosure of each of the applied references, especially in Anzures et al at col. 5:66 to 6:29.

Anzures et al do not cited an organic quaternary ammonium. However, it is known in the art to use an organic quaternary ammonium to obtain an alkaline solution to remove a soft portion of a layer in the art. Evidence, can be seen in at least Sato et al at col.2:41-64. Sato et al also disclose, teach and suggest a method of using the composition at least at col.5:61 to 6:11.

Since the above applied references are generally related to developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use, include or cited an organic quaternary ammonium for

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reasonable expectation of obtaining an alkaline solution to remove a soft portion of a layer as disclosed, taught and suggested in Sato et al.

Applicant's arguments filed 24 May 2007 have been fully considered but they are not persuasive.

The arguments have little value since the above rejection using a new set of the references.

V. Tanaka et al (5,543,268) and Tanaka et al (6,329,126) have about the same teachings and suggestions as those in the above applied Sato et al. They are cumulative.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
26 July 2007

HOA VAN LE  
PRIMARY EXAMINER  
*Hoa Van Le*

<b>Application Number</b> 	<b>Application/Control No.</b> 10/561,802 Hoa Le	<b>Applicant(s)/Patent under Reexamination</b> WASHIO ET AL. <b>Art Unit</b> 1752	
<b>Document Code - AP.PRE.DEC</b>			

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 5/24/2007.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☐ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_  
 Claim(s) objected to: \_\_\_\_\_  
 Claim(s) rejected: \_\_\_\_\_  
 Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☒ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Jennifer K. Michener

(2) Hoa Le

(3) Cynthia Kelly

(4) \_\_\_\_\_